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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diversified Gestao E Investimentos Lda.

Serial Nos. 75923398 and 75923399

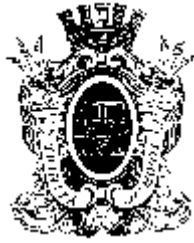
Jane F. Collen of Collen IP for Diversified Gestao E Investimentos Lda.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Seeherman and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Diversified Gestao e Investimentos Lda., a Portuguese corporation, has applied to register the marks TDM TRINITÀ' DE' MONTI and design (Serial No. 75923398) and TRINITA' DE' MONTI and design (Serial No. 75923399), both of which marks are shown below.



(Serial No. 75923398)



(Serial No. 75923399)

The applications were filed on February 22, 2000, and both are based on an asserted bona fide intention to use the marks, as well as on Section 44(e) of the Trademark Act in view of European Community registrations, with Section 44(d) claims of priority of December 28, 1999. The identification of goods for both applications is:

Household objects and tableware made of precious metals, namely, serving trays, vases, jugs, decorative boxes, bowls, statuettes, plates, glasses, cups, goblets, saucers, coasters, nutcrackers, oil and vinegar cruets, sugar bowls, centerpieces, baskets, ice buckets, non-electric coffee pots, cigar cases, cigarette cases, match holders, egg cups, toothpick holders, ashtrays, branched candlesticks, serviette rings, and key rings (Class 14);

Statuettes made of wood and non-metal key rings (Class 20); and

Household objects and tableware made of porcelain, ceramic, majolica, glass, crystal glass and steel, namely, dinner-set, coffee-set, tea-set, glasses, cups, goblets, tankards, jugs, empty bottles, oil and vinegar cures, nutcrackers, corkscrews, openers, ladles, vases, plates, coasters, centerpieces, fire-proof baking pans, non-electric coffee pots, egg cups, toothpick holders, branched candlesticks, serviette rings; and statuettes made of porcelain, ceramic, majolica, glass, and crystal glass (Class 21).

The English translation of the term TRINITA' DE' MONTI is "Trinity of the Mountains." The lining in each drawing is a feature of the mark and does not indicate color.

Registration has been refused pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that the applied-for marks falsely suggest a connection with the church Trinità dei Monti.

The appeals in each case have been fully briefed. Applicant originally requested oral hearings, but subsequently withdrew those requests. Because each appeal involves the same issue and similar records, we decide them both in this single opinion.

Section 2(a) of the Trademark Act prohibits the registration of a trademark if, inter alia, it consists of or comprises matter which may falsely suggest a connection

with persons, living or dead, institutions, beliefs, or national symbols.

In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in Notre Dame, required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; 2) that the mark would be recognized as such; 3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. This Buffett test has been followed by the Board in subsequent decisions. See *In re Urbano*, 51

USPQ2d 1776 (TTAB 1999); In re Sloppy Joe's International Inc., 43 USPQ2d 1350 (TTAB 1997); In re North American Free Trade Association, 43 USPQ2d 1282 (TTAB 1997); In re Nuclear Research Corp., 16 USPQ2d 1316 (TTAB 1990).

In the context of this ex parte proceeding, it is the Office which must establish the elements relating to the "plaintiff's" name, which is the name with which the Examining Attorney asserts the applicant's (defendant's) mark falsely suggests a connection. Because we find that the Office has not established the fourth factor set forth in Buffett, namely, that the name of the church is of sufficient fame or reputation to consumers in the United States that, when applicant's mark is used on its goods, a connection between the marks and the church would be presumed, we reverse the refusals of registration.¹

In support of his position that the name of the church is of sufficient fame or reputation to consumers in the United States, the Examining Attorney has submitted excerpts of articles taken from the NEXIS database, as well as materials from tour guides and from the Internet. (It

¹ The dissent makes the comment that "it appears that applicant has conceded the fame of the church" because of a comment made by applicant in its request for reconsideration. We do not find any such concession by applicant. For example, in its appeal brief applicant states that "it is debatable whether the Examiner has established fame." p. 5.

should be noted that the actual name of the church in Rome is Trinità dei Monti or Santa Trinità dei Monti, not Trinità de' Monti as shown in applicant's marks, although we do not regard this minor difference as sufficient to differentiate applicant's mark from the name of the church.)

Although a number of articles from the NEXIS database have been submitted, the references to the Trinità dei Monti church appear to be relatively tangential. Most of the articles are about, or feature, the Spanish Steps, which are clearly a famous tourist attraction in Rome, and the church is mentioned only because of its geographic proximity to the steps, namely, that it is located at the top of the steps. For example:

Who knows how many tourists have followed the path of Audrey Hepburn as she skipped down the Spanish Steps in Rome and into the best holiday of her life? These steps, presided over by the Trinita dei Monti Church, are one of the icons, along with the Trevi Fountain and the Pantheon, of the Tridente, a triangular area in central Rome recently declared an open-air museum by city officials.

"The New York Times," June 3, 2001

Headline: Sightseeing in running shoes
Morning treks through streets of Rome
make for memorable adventure
Body: We then venture to the Spanish
Steps, which were built in 1725 to

accommodate the many visitors to Piazza di Spagna. At the top of the stairs is the church Trinita dei Monti. We enjoy watching the numerous artists painting and sketching the surrounding views of apartments, scattered churches and, in the distance, snow-capped mountains. "The Spokesman-Review" (Spokane, WA), May 27, 2001

Best Western has a property in Rome called Hotel Canada. It is a three-star hotel with a family suite that accommodates all four of you. It includes a full breakfast.

As far as location, it sounds to me like it's well placed. I'm told it's a half mile from the Spanish Steps, the steps that lead to the church of Trinita dei Monti (Hint: get there first thing in the morning before it fills up with step-sitters); 500 meters from the Piazza della Repubblica; 900 meters from Via Veneto.... "Chicago Daily Herald," December 31, 2000

...The Spanish Steps rise from the Piazza Di Spagna and lead up to the Church; [sic] of Trinita Dei Monti, which dates to the 15th century. The steps and the; [sic] piazza are a popular gathering spot for tourists and residents alike. The; [sic] boat-shaped Barcaccia Fountain, by Bernini, is at the foot of the steps. "Pittsburgh Post-Gazette," August 13, 2000

Graphic: WHEN IN ROME: Throngs of people gather at Spanish Steps at Piazza di Spagna in Rome, Italy. Behind is the church of Trinita dei Monti.

"Ventura County Star," August 22, 1999

Meanwhile, how welcome are visitors supposed to feel here in Rome, where eating is now a minor crime on the famed Spanish Steps, the gathering place for tourists and natives adjacent to Piazza di Spagna?

City Hall and a private sponsor recently spent nearly \$1 million to weed, wash and repair the grand staircase, which rises steeply from the piazza to the twin-spired church of the Trinita dei Monti. Tourists, after having been kept away by fencing for seven months, were again free to photograph themselves against a backdrop that is as intimate a part of the city's image as the Colosseum or the Trevi Fountain. Balloons rose in the clear winter air, and a band played "Arrivederci Roma" as the steps reopened.

"The Washington Post," December 30, 1995

Headline: Big leap for Spanish Steps

Body: "This is a positive symbol of Rome but it risks becoming a negative symbol," he told a news conference.

"The steps are going to become an open-air salon once again."

The Spanish Steps, built between 1723 and 1726, are a masterpiece of Baroque architecture linking the Piazza di Spagna square with the church the Trinita dei Monti.

Occupied by trinket sellers and thousands of tourists, many of them young backpackers, the terraced flights provide some of the best views of Rome. "St. Petersburg Times," May 21, 1995

Even more tangential are references in articles about quasi-historical events or paintings:

Headline: A Woman Styled Bold: The Life of Cornelia Connelly
Body: In Rome on July 6, 1945, Pierce was ordained a priest, and on July 9 he celebrated his first Mass in the Trinita dei Monti Convent of the Religious of the Sacred Heart, where daughter Adeline was a student, and Cornelia lived as a quasi-postulant....
"The Catholic World," March 1993

Headline: Roman Holiday, 18th Century Style; exhibition "The Splendor of 18th Century Rome" co-organized by the Philadelphia Museum of Art and the Museum of Fine Arts, Houston
Body: ...The era's enthusiasm for the antique is everywhere evident, perhaps most curiously in Charles-Louis Clerisseau's ink-and-goache drawing, Ruin Room in the Convent of S. Trinita dei Monti, Rome (ca. 1766). The proto-Romanic design is for a monastic cell (which survives today) whose walls were to be painted in imitation of an ancient Roman ruin....
"Art in America," December 1, 2000

Other details of Baroque life are depicted in engravings, among them designs for furniture and chariots, views of palaces and piazzas, and spectacular fireworks displays like the one at Trinita de' Monti, the French

national church in Rome, on April 20,
1687.

"The New York Times," April 9, 1999²

The tourist guide books, too, while referring to the church, do not indicate that it is a famous tourist site. Thus, the page in the "Eyewitness Travel Guides-Italy" is headed "Street-by-Street: Piazza di Spagna," and, while it lists a variety of places that can be found near the piazza, the only one which is a "star sight" is the "Piazza di Spagna and the Spanish Steps." Trinità di Monti is listed along with Babington's Tea Rooms ("founded by two English spinsters in 1896, still serves English teas") and The Collegio di Propaganda Fide. Further, the featured write-up, comprising approximately 4 column inches, is headed "Piazza di Spagna and the Spanish Steps," and it is only in the third paragraph that there is a single mention of the church: "The steps were built in the 1720's to link

² The dissent includes an excerpt from a Christian Science Monitor article which allegedly demonstrates the fame of the church. The article is apparently a personal statement by the author, and appears to discuss the particular sights from the "modest" Pensione Pfister. The paragraph which is quoted in part in the dissent, states, in full, "The church of the Trinita dei Monti, the Spanish Steps, the fountain in the Piazza di Spagna, the palm trees, the soft late afternoon sunlight shining on the ocher-colored buildings--these memories of my first visit to Rome will remain with me always." We do not regard this listing--which includes palm trees as well as the church--as indicating that the church is regarded, even by the author, as a famous sight in Rome.

the square with the French church of Trinità dei Monti above."

In the "Lonely Planet" guide to Western Europe, again the reference to the church is tangential to the Spanish Steps. The entry is entitled "Piazza di Spagna & Spanish Steps", with the title in bold, and the following text:

This piazza, church and famous staircase (Scalinata della Trinità dei Monti) have long provided a major gathering place for foreigners. Built with a legacy from the French in 1725, but named after the Spanish Embassy to the Holy See, the steps lead to the church of Trinità dei Monti, which was built by the French.

In the 18th century the most beautiful men and women of Italy gathered there, waiting to be chosen as artists' models. To the right as you face the steps is the house where Keats spent the last three months of his life, and where he died in 1821. In the piazza is the boat-shaped fountain of the **Barcaccia**, believed to be by Pietro Bernini, father of the famous Gian Lorenzo. One of Rome's most elegant shopping streets, **Via Condotti**, runs off the piazza towards Via del Corso. (emphasis in original)

The third tour book excerpt comes from Fodor's Europe 2001. It is the Spanish Steps which is listed as the attraction, and the reference to the church is found only in the additional text:

Scalinata di Trinità dei Monti (Spanish Steps). The 200-year-old stairway got

its nickname from the nearby Spanish Embassy to the Holy See (the Vatican), though it was built with French funds in 1723, as the approach to the French church of **Trinità dei Monti** at the top of the steps. Rome's classic picture-postcard view is even more lovely when the steps are banked with blooming azaleas, from mid-April to mid-May. (emphasis in original)

The Examining Attorney has also submitted various pages taken from Internet websites. Two of them refer to religious topics. The first, an article entitled Mater Admirabilis, is from the website of Woodlands Academy of the Sacred Heart in Lake Forest, Illinois. The article states that "Trinita dei Monti, the monastery which is home to Mater Admirabilis, was founded in the fifteenth century," and that it "has become a center for the Religious of the Sacred Heart and all others visiting the shrine of Mater Admirabilis." The article goes on to tell the story of the fresco of Mater Admirabilis, which story took place in the 1840's.

Another article regarding religious history comes from the website of New Advent Catholic Encyclopedia. The article is about "Minimi," which are the members of the religious order founded by St. Francis of Paola. The article provides an extensive discussion about the history of Minimi. About halfway through the three-page article,

there is a brief reference to Trinita dei Monti, namely, "In 1495 Charles VIII of France founded in Rome the convent of Trinita dei Monti, which, by Bull of Innocent X (1645), was exclusively reserved to the French fathers."

An excerpt from <http://myweb.worldnet.net> has the headline "Trinita dei Monti, Rome, A timeless place confronts the 21st Century." It discusses the "famous Piazza di Spagna," and states that Roman youth "sit on the staircase which leads to the Pincian hill. From this majestic summit, the edifice of Trinita dei Monti appears to perpetually contemplate the Eternal City." The article goes on to discuss the history of the church, explaining that it was founded by Charles VIII of France in 1495 as a convent for French Minim monks, and that it was an important institution of pontifical Rome:

After the Revolution, the Minim monks, no longer able to ensure a significant presence, were replaced by the Religious of the Sacred Heart who created a school intended to spread the influence of the French culture among the elite of Italy. To this day, they still occupy this prestigious house.

A submission from the website www.nerone.cc states that it was prepared for Nerone the Insider's Guide to Rome. Entitled "Walking in the Vicinity of Santa Trinita' Dei Monti," it first discusses the Convent of SS Trinita

dei Monti, "up some steps to the left of the main entrance to the church." "The convent of Santa Trinita dei Monti The Convent of Santa Trinita dei Monti [repetition in original] was originally established as a monastery for a minor order founded by Saint Francis di Paola." The article discusses the frescoes and other decorations in the convent. It then talks about the sights as one leaves the convent and goes past the church into the piazza by the Hassler Hotel.

The website for www.letsgo.com lists various sights in Rome. Under the general listing of "Piazza Di Spagna and the Corso" are, inter alia, "Spanish Steps," and below the listing of "Near the Steps" are the Church of Santa Trinita' Dei Monti and Villa Mèdici. The specific listing for the Church contains two long paragraphs about the church, including its history and paintings.

The website for BBC News, <http://news.bbc.co.uk>, has an article dated June 12, 2002 reporting that "the public are being allowed rare access to a 16th Century convent full of Renaissance frescoes at the top of Rome's Spanish Steps. The exhibition—which opened on Wednesday—at Trinita dei Monti also features hundreds of paintings, drawings and ancient manuscripts."

Finally, the website for "MSN Learning & Research", <http://Encarta.msn.com>, has a picture entitled "Piazza di Spagna, Rome," with the caption, "Tourists in Rome gather on the Spanish Steps. Built in the 18th century, these steps lead up to the Trinità dei Monti church, constructed in the 15th century in the Piazza di Spagna.

After a thorough review of the evidence, we find that the Office has not established that Trinità dei Monti has sufficient fame or reputation to consumers in the United States that they would assume a connection between the church and applicant's identified goods sold under the applied-for marks. Although there is clearly a church and a convent in Rome which is referred to as "Trinità dei Monti," on this record we cannot conclude that either the church or convent is a well-known tourist attraction or that it has well-known historical significance, such that consumers in the United States would be aware of the name.³

³ The Examining Attorney states that "the Church is enriched with works of art by some of the great artists of that century including Michelangelo." Brief, pp 3-4. However, in our review of the record we have not found any reference to works by Michelangelo in the church. Rather, the listing in myweb.worldnet.net states "the great artists of the century of Michelangelo enriched the church and the convent" (without naming any artists). None of the tourist books refers to the works of any particular artists. The dissent comments that "the famous frescoes of pupils of Michelangelo and Raphael draw many tourists to the church." However, the BBC internet excerpt indicates that the frescoes in the convent are generally not available for viewing by tourists. The excerpt does state that "the church

The Examining Attorney has obviously done a thorough search in his quest for evidence. However, of the 21 articles from NEXIS that he submitted, not one suggests that the church itself is famous. In *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987), the Court commented that "It is indeed remarkable to see the thoroughness with which NEXIS can regurgitate a placename casually mentioned in the news." The same can be said in the present situation. In the NEXIS excerpts which the Examining Attorney has made of record, the references to the church are not the focus of the articles. In general, the church is mentioned simply because it is located at the top of the Spanish Steps.

With respect to the Internet evidence, although the Internet is a wonderful tool for retrieving information, the simple fact that such information can be retrieved does not mean that the information would be known by the general

itself is already famous for its frescoes," but these assertedly famous frescoes are by Naldini, Perin del Vaga and Zuccari. We think there is at least some question as to whether any significant number of American consumers would be aware of these artists and their frescoes, let alone whether they would know of the name of the church in which they are located.

The dissent also states that "the fact that this [Trinità dei Monti] is the French national church in Italy and is known as the Church of the Kings of France undoubtedly increases the renown of this church." However, it is not clear how the fact that Trinità dei Monti was the French national church in Italy and the church of the kings of France more than 200 hundred years ago demonstrates the renown of the church in the United States today.

public in the United States. We note, in this connection, that the website <http://myweb.worldnet.net> appears to be a foreign source: the word "centre" uses the British spelling, and the French word "suite" is used rather than the word "continue" which is found on most U.S. websites. Similarly, we have no information about the Nerone Insider's Guide to Rome, except we note that the website address is a foreign one, as is the website for the BBC. It is not clear to what extent these websites are directed to consumers in the United States, or the exposure such consumers would have to them.

Accordingly, we find that the Office has not met its burden of proving that the Trinità dei Monti church is of sufficient fame or reputation to consumers in the United States that a connection between applicant's marks and the church would be presumed.⁴ In view of this finding, we need

⁴ The dissent seems to suggest that because the Spanish Steps are famous, and these steps lead to the Trinità dei Monti church, the church would also have the reputation or renown necessary to support a finding of a false suggestion of a connection. It should be noted, however, that the Spanish Steps and the church are separate structures; the Spanish Steps do not lead only to the church, such that they would be recognized as part of the same complex. As a result, the fact that the Spanish Steps are famous does not necessarily result in the church located at the top of the steps also being famous. Moreover, although the official name of the Spanish Steps is "Scalinata della Trinità dei Monti," it is not clear from the record that consumers in the United States, including Italian-speaking consumers, would generally be aware of the official or formal name. The bulk of the references in the record refer to the steps as simply the Spanish Steps.

not discuss the other Buffett factors.⁵

As a final note, we recognize that because these applications are not based on use in commerce, applicant has not submitted any specimens of use. Should the Examining Attorney, upon review of such specimens, determine that the applied-for marks are descriptive of the goods, the Examining Attorney would be free to raise a merely descriptive refusal under Section 2(e)(1) at that point. Moreover, our decision herein is necessarily based on the record before us; we might reach a different result on the ground of a false suggestion of a connection on a different record, such as might be adduced in an inter partes proceeding.

Decision: The refusals of registration are reversed.

⁵ The dissent makes the comment that the majority appears to require the Examining Attorney to prove elements not previously required, and suggests that it is the majority's position that the Examining Attorney must demonstrate that consumers would expect the church to sell or sponsor goods of the nature produced by applicant. We reiterate that the only factor which we have discussed in the majority opinion is whether the Examining Attorney has shown that the church is of sufficient fame or reputation in this country that a connection between the marks and the church would be presumed. This requirement is not a new element, but was first set forth by the Board almost twenty years ago in the Buffett decision, and has been reiterated in numerous decisions since.

Simms, Administrative Trademark Judge, dissenting:

I dissent from the conclusion of the majority that the relevant public would not consider applicant's marks as falsely suggesting a connection with the church and convent called Trinità dei Monti or Trinità de' Monti. The record amply shows that these words in applicant's marks point uniquely to and are unmistakably associated with this famous historical church and convent (former monastery) in Rome.

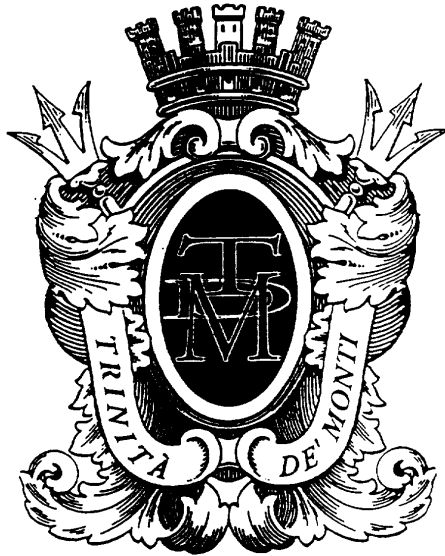
In the seminal case of *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court interpreted the language--"false suggestion of a connection"--of Section 2(a) and set forth some principles for determining whether a mark falsely suggests a connection within the meaning of that section of the Act. To begin with, the Court indicated that the drafters of the Trademark Act were concerned with protecting the name of an individual or institution, which may not have been used as a technical trademark or trade name. This section embraced concepts of the right of privacy, according to the Court. The Court stated that the legislative history indicated that Section 2(a) was intended to preclude the registration of a mark which conflicted with another's rights, even though not

founded on likelihood of confusion. There might be no likelihood of confusion as the result of sponsorship or endorsement, yet the right of privacy or the related right of publicity might be violated under Section 2(a). This right includes the right to control the use of one's identity, the Court stated.

In determining whether a mark falsely suggests a connection with a person or institution, the Court stated, 217 USPQ at 509, that "the initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or 'persona.'" The asserted mark must point uniquely to the aggrieved person or institution. In the *Notre Dame* case, the Court concluded that this name served to identify a sacred religious figure, the names of various churches, as well as the University. The Court noted, therefore, at 217 USPQ 509:

This conclusion [of no false suggestion because the mark does not point uniquely to one institution] could be changed if the evidence showed that [applicant] intended to identify the University, as the University argues. Evidence of such intent would be highly persuasive that the public will make the intended false association. The defense that the result intended was not achieved would be hollow indeed.

There can be no doubt that the words Trinità dei Monti identify a church and convent in Rome. First, the fact that applicant's marks (shown below) include the word "de'" is insignificant because this word is an abbreviation of "dei," which means "of the."⁶ The use of the apostrophe demonstrates a contraction of the word "dei."



⁶ Cassell's Italian Dictionary (1967).

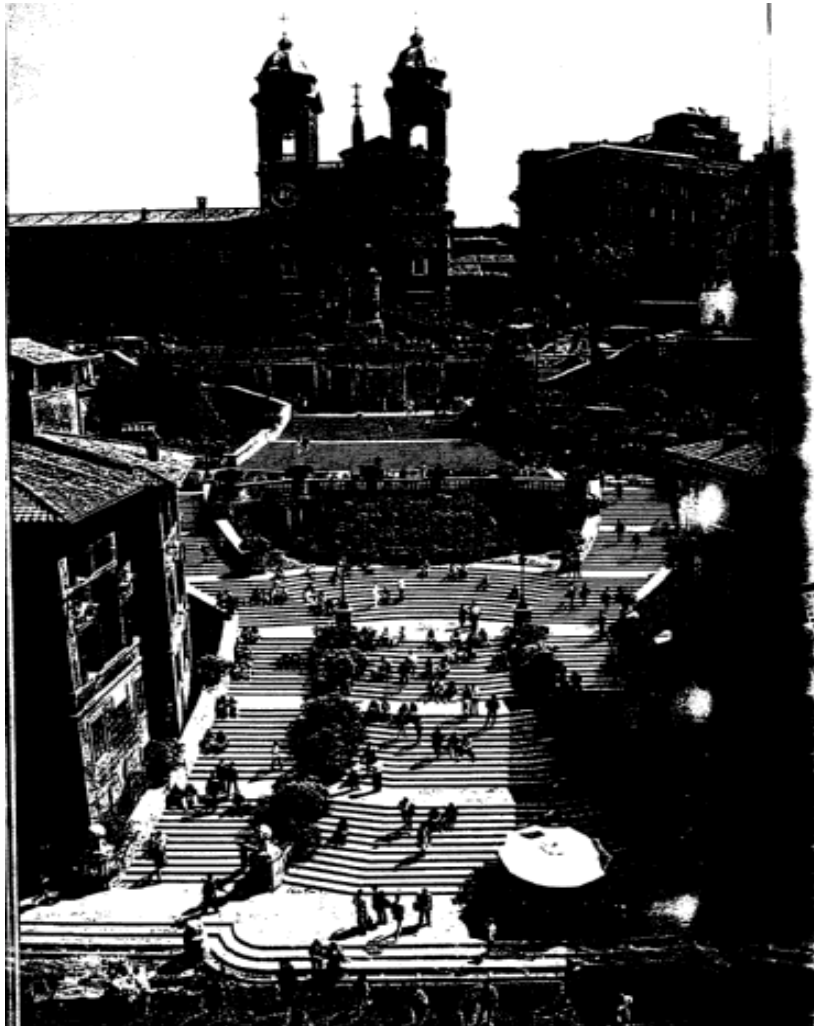
Second, while applicant has noted that other places bear this name, a close examination of this record indicates that these other places are named after the church of Trinità dei Monti because of their close proximity to that church. For example, the Spanish Steps, which the majority notes is a famous tourist spot in Rome, is called Scalinata della Trinità dei Monti in Italian.⁷ This Italian name is literally translated as "Staircase (or Flight of steps) of the Trinity of the Mountains" or "Staircase of the Trinità dei Monti."⁸ In other words, the famous Spanish Steps are named in Italian after the church at the top of those steps to which they lead.⁹ Indeed, the Steps were built, according to material of record, to provide access to that church. See the photo below from this record, showing that the church of Trinità dei Monti towers over the Spanish Steps. Applicant's argument that the public could associate Trinità dei Monti with the Spanish Steps as well as other places, therefore, has no merit. And to the extent that the not-insignificant number of Italian-speaking people in this country know the Italian name for the famous Spanish Steps, this awareness increases

⁷ The word "della" also means "of the". *Id.*

⁸ *Id.*

⁹ Applicant's attorney notes that the nickname of this staircase is the "Spanish Steps" but that the formal name is "Scalinata della Trinità dei Monti."

the renown of the church after which the Steps are formally named.



Also, the Piazza della Trinità dei Monti ("Square of the Trinità dei Monti") is located next to the church. The Hotel Trinità dei Monti is located near the church in the Piazza di Spagna (once called Piazza della Trinità dei Monti) at the foot of the Spanish Steps, and the two pilgrimage houses are undoubtedly located nearby as well.

In this regard, it is not uncommon for hotels and other places of lodging to be named after nearby tourist attractions. For example, a hotel located near the Eiffel Tower in Paris may well include the phrase "Tour Eiffel" in its name. This merely indicates to tourists the location of the hotel and does not serve to detract from the association of the name with the attraction. Accordingly, and contrary to applicant's argument that these uses of the phrase Trinità dei Monti detract from the unique name of the church, all of these usages not only refer to the nearby church but also tend to popularize that institution. This is especially the case with respect to the Spanish Steps, itself bearing an Italian name after the church Trinità dei Monti. Therefore, unlike the *Notre Dame* case, where the words "Notre Dame" were not solely associated with the University of Notre Dame, here there is no evidence to suggest that Trinità dei Monti refers to anything other than the famous historical church in Rome that has existed for nearly 500 years. Except for these nearby places (Staircase, Piazza, hotel and pilgrimage houses), applicant has not pointed to any place or institution named Trinità dei Monti.

Further, applicant contends that, because its marks include other elements, such as a crest design, towers in crown-like form and the letters TDM, applicant's marks are not the same name as the institution or church Trinità dei Monti. First, it is clear that in one of applicant's marks, the words Trinità de' Monti predominate. In the other, the letters TDM have obvious reference to Trinità dei Monti, and would readily be perceived as an abbreviation for Trinità dei Monti. Moreover, I fully agree with the Examining Attorney that more weight should be given to the literal portion of the marks (Trinità dei Monti) because that phrase is more likely to be impressed on a purchaser's memory and be used in calling for or recommending the goods sold under these marks.

The Court in the *Notre Dame* case also noted that an applicant's intent in identifying the person or institution would be highly persuasive that the public will make the intended false suggestion. Here, there is absolutely no indication that applicant independently came up with this arbitrary name on its own for its goods. This name points uniquely to and is unmistakably associated with the church. As the Court stated, "The defense that the result intended was not achieved would be hollow indeed." Applicant's

argument that these words in its marks do not solely point to the church ring hollow indeed.

The majority concludes that the record does not demonstrate that Trinità dei Monti "has sufficient fame or reputation to consumers in the United States." The record belies this conclusion. The record includes 21 representative excerpts from the Nexis database, including from such publications as *The New York Times*, *The Washington Post*, *USA Today*, *Chicago Tribune*, *Baltimore Sun*, *Christian Science Monitor*; three travel guides including Fodor's 2001-Europe, the *Conde Nast Traveler* travel magazine and eight Web sites. Some of the excerpts indicate the fame of this church. For example:

Who knows how many tourists have followed the path of Audrey Hepburn as she skipped down the Spanish Steps in Rome and into the best holiday of her life? These steps, presided over by the Trinita dei Monti Church, are one of the icons, along with the Trevi Fountain and the Pantheon, of the Tridente, a triangular area in central Rome recently declared an open-air museum by city officials.

The New York Times, June 3, 2001

* * *

... And another imperial-Roman replica, fake hieroglyphics and all, faces the Church of Trinita dei Monti atop the Spanish Steps. It forms part of a celebrated view that like few others conveys the essence of Rome.

The New York Times, January 14, 1996

* * *

City Hall and a private sponsor recently spent nearly \$1 million to weed, wash and repair the grand staircase, which rises steeply from the piazza to the twin-spired church of the Trinita dei Monti. Tourists, after having been kept away by fencing for seven months, were again free to photograph themselves against a backdrop that is as intimate a part of the city's image as the Colosseum or the Trevi Fountain. Balloons rose in the clear winter air, and a band played "Arrivederci Roma" as the steps reopened.

The Washington Post, December 30, 1995

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Let's just assume, as millions of tourists do every year, that the Spanish Steps are the heart of Rome, and not just an 18th-Century stairwell of spectacular grace and Baroque beauty, leading from the Piazza di Spagna up to the convent at Trinita dei Monti.

Chicago Tribune, July 30, 1995

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The church of the Trinita dei Monti, the Spanish Steps, the fountain in the Piazza di Spagna...these memories of my first visit to Rome will remain with me always.

The Christian Science Monitor, June 2, 1992

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The steps, overlooking the central Piazza di Spagna, rise to the Trinita dei Monti church, where tourists for centuries have enjoyed the views of Rome.

In recent years the Spanish Steps have become a popular meeting place for the city's youngsters and backpackers, some of whom have used them as an open-air dormitory *The Orange County Register*, November 12, 1995

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This piazza [Piazza di Spagna], church and famous staircase (Scalinata della Trinita dei Monti) have long provided a major gathering place for foreigners.
Lonely Planet-Western Europe (4th ed.)

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Scalinata di Trinità dei Monti (Spanish Steps). The 200-year old stairway got its nickname from the nearby Spanish Embassy to the Holy See (the Vatican), though it was built with French funds in 1723, as the approach to the French church of **Trinità dei Monti** at the top of the steps. Rome's classic picture-postcard view is even more lovely when the steps are banked with blooming azaleas, from mid-April to mid-May. (Emphasis in original.)
Fodor's 2001-Europe, p. 654.

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Built on the still visible vestiges of Ancient Rome, Trinita dei Monti has gained enormous prestige through its five-hundred year history. It was in 1495 that the king of France, Charles VIII - acquired the land and founded a convent of French Minim monks. The monastery was built at the end of the Italian Renaissance, thanks to the generosity of the kings of France, who involved other major patrons: princes, cardinals and French ambassadors. Under such prestigious protection,

Trinita dei Monti quickly became one of the most important institutions of pontifical Rome. While the great artists of the century of Michelangelo enriched the church and the convent with major pictorial works, the monks acquired an undeniable cultural influence... After the Revolution, the Minim monks, no longer able to ensure a significant presence, were replaced by the Religious of the Sacred Heart who created a school intended to spread the influence of the French culture among the elite of Italy. To this day, they still occupy this prestigious house.
myweb.worldnet.net

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Trinita dei Monti's famous cupolas overlook the steps [text underneath photograph of Trinita dei Monti church]. The public are being allowed rare access to a 16th Century convent full of Renaissance frescoes at the top of Rome's Spanish Steps. The exhibition-which opened on Wednesday-at Trinita dei Monti also features hundreds of paintings, drawings and ancient manuscripts... The public can tour the church, the cloister and the refectory, which contain many beautifully decorated murals. The complex was started in 1502 by King Louis XII of France... The church itself is already famous for its frescoes...
news.bbc.co.uk

* * *

Famous all over the world as the Spanish steps... The idea to create it was caused by the necessity to make an appropriate access to the French church of Trinita dei Monti.
www.italyberguide.com

Moreover, it appears that applicant has conceded the fame of the church. In its Request for Reconsideration, 6,

applicant states, "While the Examiner has provided information indicating that the church is famous, there is no evidence that the average American consumer would expect fine household goods... to emanate from a church."¹⁰ Applicant then went on to argue that there was no false suggestion under the law because, among other things, applicant's marks included other elements rather than just the name of the church, and that the phrase "Trinità dei Monti" was not unmistakably associated or did not point uniquely to the church. The fact that this church is the French national church in Italy and is known as the Church of the Kings of France undoubtedly increases the renown of this church.

The Examining Attorney has represented, and applicant has not refuted, that Rome is the third most popular foreign tourist destination for U.S. travelers. While the majority seems to minimize the importance of the mentions of this church, finding references to it to be sometimes "relatively tangential," it is often mentioned in conjunction with the admittedly famous Spanish Steps (known by the Italian name "Scalinata della Trinità dei Monti"), which is a well-known gathering place in Rome for natives

¹⁰ In its brief, 5, applicant states that "in this case [it] is debatable whether the Examiner has established fame...."

and visitors alike. As shown in the photograph above, it is difficult to believe that, while the Spanish Steps are one of the prime tourist spots in Rome, the church which towers above the Steps, to which the Steps lead and after which they are formally named, is not also well-known. Also, as indicated in the excerpts, the famous frescoes of pupils of Michelangelo and Raphael draw many tourists to the church. In my view, the record demonstrates a prima facie case that the church is sufficiently famous that a false connection with that church will be presumed by applicant's marks on merchandise bearing the name Trinità De' Monti.

The Examining Attorney's position that it is not uncommon for institutions or other organizations to license their names for promotional merchandise is well taken. In this case, the applications are based upon applicant's intention to use the marks set forth therein. We do not yet know what images, if any, applicant may place on its serving trays, vases, jugs, bowls, plates, cups, saucers, coasters, etc. However, in view of the nature of the marks applicant seeks to register, and the fact that there is no other church or institution in the world bearing the words Trinità dei Monti, at least as reflected by this record, I believe that one may permissibly assume that images of the

church may appear on these goods. In any event, consumers are likely to presume a false connection between applicant's goods and the church because of the name Trinità De' Monti on applicant's goods.

In this regard, the majority appears to require the Examining Attorney to prove elements not previously required by judicial or TTAB authority. The majority initially notes that, under existing Board precedent, the Office must establish four elements, including that applicant's mark is the same as or a close approximation of the aggrieved person's or institution's identity, and that the name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with the aggrieved person or entity would be presumed. If it is the majority's position that, in addition, the Examining Attorney has failed to demonstrate that consumers in this country would expect the church to sell or sponsor goods of the nature produced by applicant, I disagree. This is not a requirement of the claim being asserted by the Examining Attorney as a ground for refusal here. The Examining Attorney has refused registration on the basis that applicant's mark, when used, will falsely suggest a connection with the church in Rome that operates under the name Trinità dei Monti. Case law is now clear

that Section 2(a) embraces concepts of the right of privacy (and publicity) which may be violated even in the absence of likelihood of confusion. As the Court observed in *Notre Dame*, 217 USPQ at 509, "There may be no likelihood of such confusion as to the source of goods even under a theory of 'sponsorship' or 'endorsement,' and, nevertheless, one's right of privacy, or the related right of publicity, may be violated." By requiring more than the case law suggests and by requiring the Examining Attorney to demonstrate something akin to likelihood of confusion (that American consumers would think that this Italian church would sell or sponsor goods similar to applicant's) when the ground is false suggestion under Section 2(a), if that is what the majority would require, I believe this incorrectly places an unwarranted burden on the Office. Under the false suggestion provision of Section 2(a), the church is entitled to protect its right of privacy, its right of publicity and the right to control the use of its identity, which could include any right to royalties or fees for the use of its name.¹¹ As the Court indicated, the critical

¹¹ While some of the evidence seems to indicate that private companies, rather than the churches themselves, sell plates and other souvenir objects, it is not at all clear that the churches may not in fact receive some remuneration from the sale of these objects. It is probably unlikely that a church would engage in the manufacture of such goods on its own, but would more likely have such goods made for it.

requirement under this part of Section 2(a) is that the asserted word or words in question be unmistakably associated with or point uniquely to a particular person or institution. The Examining Attorney has prima facie established this element, and applicant has not rebutted it.

In sum, purchasers are likely to believe that the religious institution Trinità dei Monti, of which applicant's goods bear the name, is in some way associated with, sponsors, authorizes or licenses these goods, or that, even aside from these considerations of sponsorship or endorsement, the church's right of privacy and the related right to control its own identity has been violated, contrary to the provisions of Section 2(a). This is especially the case because Trinità dei Monti is an active church and convent, not merely a famous historical landmark. Because I believe that the name Trinità dei Monti in applicant's marks will falsely suggest a connection with this uniquely named church in Rome, I would affirm the refusals under Section 2(a) of the Act.